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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/804,523	03/19/2004	Thomas M. Verrengia	17073	7530

7590 03/18/2005

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EXAMINER	
CHIU, RALEIGH W	

ART UNIT	PAPER NUMBER
3711	

DATE MAILED: 03/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/804,523	VERRENGIA, THOMAS M.	
	Examiner	Art Unit	
	Raleigh Chiu	3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 December 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-10,18 and 20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-10,18 and 20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *19 March 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claims 1-3, 5, 6 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Colarusso (USPN 5,733,213) in view of Bellehumeur (USPN 5,597,161) as previously applied.

3. Claims 4, 9 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Colarusso and Bellehumeur in view of Licursi (USPN 6152842) as previously applied.

4. Claims 7, 8 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Colarusso and Bellehumeur in view of Kotler (USPN 5,816,965) as previously applied.

Response to Arguments

5. Applicant's arguments filed 27 December 2004 have been fully considered but they are not persuasive.

Applicant argues that there is "no showing of the level of the level of skill in the art at the time of the invention any [*sic*, and] why such a combination would have been obvious to one of ordinary skill in the art at that time" (Remarks, page 7). An inspection of Colarusso (Figure 22) and Bellehumeur (Figures

7-10 and 15-17) clearly show the level of ordinary skill in the art at the time of the instant invention. That is to say, both Colarusso and Bellehumeur show that, at the time of the invention, the concept of placing friction-reducing runners about the periphery of a hockey puck to allow the puck to glide more easily is old and well-known in the hockey puck art.

Applicant also argues that there is no "showing of a specific motivation or suggestion why one of ordinary skill in the art at the time of the invention would use the peripheral plugs of Bellehumeur in the openings of Colarusso" (Remarks, page 7). As discussed in the previous Office action, Colarusso shows two discrete runners within each peripheral opening. See Figure 22 of Colarusso. However, the previous Office action clearly states that Bellehumeur shows the equivalence between discrete and separate plugs in a hockey puck. See Figures 7-10 and 15-17 of Bellehumeur. It has been generally recognized that the selection of one known equivalent for another is within the level of ordinary skill in the art.

Applicant's argument that where "a feature is not shown or suggested in the prior art references themselves, the Federal Circuit has held that the skill in the art will rarely suffice to show the missing feature" (Remarks, page 7) is inapt since Bellehumeur explicitly shows the missing feature of a peripheral

plug disposed in the peripheral openings such that the plug extends above both the upper and lower surfaces of the puck. See Figures 7-10 and 15-17 of Bellehumeur. Applicant has done no more than to select features from the prior art and incorporate them into a unitary feature without materially altering the structure or function of each individual feature and without producing any new or unexpected result. Further, to select features from the prior art to effect results expected from these features is within the purview of 35 USC § 103.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper.

Regarding claims 4, 9 and 18, at the time of the invention, the teachings of Colarusso, Bellehumeur and Licursi were clearly known.

With further regard to Licursi, applicant argues that the rejection "does not make a showing of a specific motivation or

suggestion why one of ordinary skill in the art at the time of the invention would combine the teaching of Bellehumeur and Colarusso with Licursi" (Remarks, page 9) yet acknowledges that the previous Office action states that "it would have been obvious to one of ordinary skill in the art to size the peripheral plugs to cover a substantial portion of the puck periphery in view of Licursi who teaches that such a construction allows for better puck stability over an irregular surface" (Remarks, page 8). To provide better puck stability over an irregular surface is considered to be such a showing of a specific motivation or suggestion.

Further, applicant admits that "Licursi teaches a construction which provides a smoother glide over an irregular surface" (Remarks, page 9), yet does not accept that Licursi allows for better puck stability over an irregular surface. It is noted here that a smoother glide over an irregular surface inherently provides better puck stability over an irregular surface.

The comments regarding claims 7, 8 and 10 are repeated. No specific arguments have been directed against the rejection of the claims.

6. The affidavit under 37 CFR 1.132 filed 27 December 2004 is insufficient to overcome the rejection of claims 1-10, 18 and 20

based upon commercial success and long-felt need as set forth in the last Office action.

Regarding the affidavit with respect to alleged commercial success, the statements by Newton, Fink and Saylor fail to establish a nexus between the claimed invention and evidence of commercial success in that there is no showing that such success occurred in a marketplace where the consumer is free to choose on the basis of objective principles, and that such success is not the result of heavy promotion or advertising, shift in advertising, consumption by purchasers normally tied to applicant or assignee, or other business events extraneous to the merits of the claimed invention. A mere allegation that there was commercial success of an article which embodied the invention is not effective. Moreover, vague general statements such as "substantial orders" (Newton) and "my accounts have shown a substantial interest" (Fink) lack any context with respect to the overall market and can hardly be considered evidence of commercial success. Unverifiable potential estimates of 12,000 units (Saylor) clearly do not show commercial success without evidence of the state of the market, such as market share; gross sales figures, especially future estimates of sales, do not show commercial success absent evidence as to market share. Furthermore, conclusory statements

in the form of opinions that increased sales were due to the merits of the invention are entitled to little weight.

Regarding the affidavit and a long-felt need, there is no objective evidence that an art-recognized problem existed in the art for a long period of time without solution. While affiants allege that the claimed invention provides improved performance, there is no evidence of any prior unsuccessful attempts to do so. A mere conclusory statement that such a need existed, without more, is clearly insufficient. That is to say, in other words, there is no evidence as to the date when this allegedly long-felt was identified, and certainly no evidence provided as to efforts to solve that problem.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

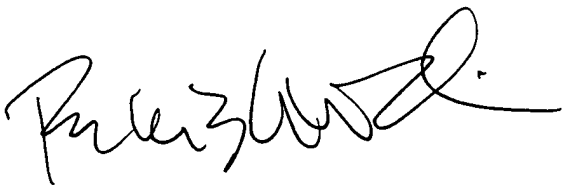
extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raleigh Chiu whose telephone number is (571) 272-4408. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich, can be reached on (571) 272-4415.

The fax number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Raleigh W. Chiu
Primary Examiner
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RWC:dei:feif
15 March 2005